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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/679,969	10/05/2000	Motoshi Tanaka	P/2291-90	1249
7590	02/17/2004		EXAMINER	
STEVEN I. WEISBURD DICKSTEIN SHAPIRO, MORIN & OSHINSKY, LLLP 1177 AVENUE OF THE AMERICAS 41ST FLOOR New York, NY 10036-2714			TRAN, PABLO N	
			ART UNIT	PAPER NUMBER
			2685	10
			DATE MAILED: 02/17/2004	

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/679,969	TANAKA, MOTOSHI	
	Examiner	Art Unit	
	Pablo N Tran	2685	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
 THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 21 November 2003.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-26 is/are pending in the application.
 - 4a) Of the above claim(s) 1-9 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 10-26 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 10-26 have been considered but are moot in view of the new ground(s) of rejection.
2. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
3. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Specification

4. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o).

Regarding claim 19, the limitation "wherein, responsive to the processor, the telephone has established the connection in touch-tone mode" is objected to as failing to provide proper antecedent basis for the claimed subject matter. Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. Claim 19 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, "wherein, responsive to the processor, the telephone has established the connection in touch-tone mode", which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 10-13, 15-17, and 19-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Murai et al.* (JP61224645A) in view of *Borland* (6,320,943).

As per claims 10 and 26, *Murai et al.* disclosed a method for transferring a phone number from a first telephone to a second telephone, which are in connection, wherein

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at the first telephone producing transmission data including a desired phone number and transmitted the transmission data through the connection and wherein at the second telephone receiving the desired phone number included in the transmission data from the first telephone and displaying & storing the received desired phone number (see English abstract).

Murai et al. do not specifically disclose that the transmission data having a first data field that includes an ID code and a second data field that includes a telephone number. However, such method of sending a transmission data that includes a first and second data field as disclosed is well known in the art, as taught by *Borland* (see fig. 2, col. 4/ln. 50-col. 5/ln. 16). Therefore, it would have been obvious to one of ordinary skill in the art to provide the transmission data having such fields, as taught by *Borland*, to the transmission data of *Murai et al.* in order to prioritize or optimize such information so that the user can easily access to such information.

As per claims 11, the modified system of *Murai et al.* do not specifically disclosed making the call to the stored desired phone number depending on the user's instruction. However, such is notoriously well known in the art that the examiner takes Official Notice of such. In order to provide convenient to the user such phone number is stored in a directory and retrieved to make a call upon the user's instruction.

As per claims 12, 16, and 22, the modified system of *Murai et al.* disclosed when the telephone call is in progress with the second telephone, the predetermined data (desired phone number) is transmitted to the second telephone depending on an

instruction inputted by the user through the input device (see *Murai et al.*, English abstract).

As per claims 13, 17, and 23, the modified system of *Murai et al.* do not specifically disclosed the desired phone number is retrieved from a phone directory memory depending on the user's instruction. However, such is notoriously well known in the art that the examiner takes Official Notice of such. In order to provide convenient to the user such phone comprises a phone directory used to stored number for later used and also to retrieved stored number to make a call upon the user's instruction.

As per claims 15 and 20-21, as stated above in claim10, the modified system of *Murai et al.* further disclosed a transceiver, a display, an input device, a memory, and a processor (see *Murai et al.*, fig. 2).

As per claims 24-25, the modified system of *Murai et al.* disclosed the memory is a received data or phone directory memory (see *Borland*, fig. 2, col. 4/ln. 50-col. 5/ln. 16).

8. Claims 14 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Murai et al.* (JP61224645A) in view of *Borland* (6,320,943) and further in view of *Shimoda* (JP09233215A).

As per claims 14 and 18, the modified system of *Murai et al.* do not specifically disclose the desired phone number is produced by speech recognizing voice data corresponding to digits of the desired phone number. However, such method of character-to-speech conversion is well known in the art, as taught by *Shimoda* (see English abstract). Therefore, it would have been obvious to one of ordinary skill in the

art to provide such method of character-to-speech conversion, as discussed in *Shimoda*, to the telephone device of the modified system of *Murai et al.* in order to provide convenient to the user.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Lee (6,351,637), Homayoun (5,940,471), Lopponen et al. (5,781,860), and Schellinger (5,488,649) disclose radiotelephone communication system.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pablo Tran whose telephone number is (703)308-7941. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Urban, can be reached at (703)305-4385.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 872-9314 (for Technology Center 2600 only)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.

PABLO N. TRAN
PRIMARY EXAMINER

February 13, 2004



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